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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,981	01/02/2004	Jie Wu	ALL003	5199
35830	7590	02/07/2005	EXAMINER	
LAWRENCE N. GINSBERG			PATEL, PARESH H	
21 SAN ANTONIO			ART UNIT	PAPER NUMBER
NEWPORT BEACH, CA 92660-9112			2829	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 10/750,981	Applicant(s) WU, JIE	
	Examiner Paresh Patel	Art Unit 2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6, 10-13, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 14-17 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Applicant's election of species of fig. 2-3, claims 1-5, 7-9 and 14-20 in the reply filed on 12/08/2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 6 and 10-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species of fig. 4-5, fig. 6-7 and 8, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/08/2004.

Claim 18 is also withdrawn because it does not read on elected species of fig. 2-3. Loader/unloader 150 of fig. 2-3 performs **simultaneous** operation for loading, testing and unloading the two groups of electronic devices. Therefore, as claimed here unloading the first group of electronic device after step (b) of claim 14 is not supported in the specification of fig. 2-3.

Claim 19 is withdrawn because it depends from withdrawn claim 18 and for the same reason as withdrawn claim 18.

Claim Objections

Claim 16 is objected to because of the following informalities: "the test site" should be --a test site--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 7-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites, inter alia, two device interfaces 130 and 230, each of which is connectable to a corresponding group of electronic devices 182 and 282 **through a second connection**, wherein "a second connection" is not enabling from the disclosure because it is not described in the specification or in the drawing (particularly in elected fig. 2-3). Loader/unloader 150 of fig. 2-3 can't be a second connection because it is individually claimed in claim 4 (and hence it is different from a second connection), wherein claim 4 is depends from claims 3, 2 and 1. Therefore, a second connection as claimed is not clear from the specification or drawing to make and use the invention.

Dependent claims 2-5 and 7-9 are also rejected because they depend from rejected claim 1.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 7-9 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, what is not clear is "a second connection". It is indefinite because second connection is not defined in the specification or shown in the drawing to understand how it related to device interface 130/230 and group of electronic devices as claimed.

Dependent claims are also rejected because they depend from rejected claim 1

Regarding claim 16, it is unclear from the specification that what is test site. It could be either element 130/230 or 100. Which makes claim indefinite.

Claim 16 recites the limitation "the test site" in line 3. There is insufficient antecedent basis for this limitation in the claim.

For the purpose of Examination and in order to expedite the prosecution, it is assume that test site is element 130/230.

With respect to claims 1-5 and 7-9 art can't be applied.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14, 16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Onishi et al. (US 6225798).

Regarding claim 14, Onishi et al. (hereafter Onishi) in fig. 5-6 discloses a method of automatically testing electronic devices comprising the steps of:

in a primary test cycle,

(a) connecting a first group of electronic devices [ICs 13 under test loaded on tray 1] to a tester interface [15a or test station TS1] for testing [using 1a and 1b, see fig. 5];

(b) disconnecting [from test station TS1 for TS2] the first group of electronic devices from the tester interface upon completion of the testing;

(c) connecting a second group of electronic devices [ICs of tray 2] to the tester interface [TS1] for testing;

(d) disconnecting [from TS1 for TS2] the second group of electronic devices from the tester interface upon completion of the testing.

Regarding claim 16, Onishi in fig. 6 discloses the method as claimed in claim 14, further comprising a step of, **after the completion of step (d)**, unloading the first group [from 15b] and a second group [from 15a] of electronic devices from the test site.

Regarding claim 20, Onishi in fig. 6 discloses the method as claimed in claim 14, further comprising a plurality of subsequent test cycles (measurement cycles M) repeating the steps of the primary test cycle.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi (fig. 6-7) as applied to claim 14 above, and further in view of Onishi (fig. 8 and 5).

Regarding claim 15, Onishi in fig. 6-7 discloses all the elements except for the method as claimed in claim 14, further comprising a step of, **before the step (a)**, loading a first group and a second group of electronic devices to a test site. Onishi in fig. 8 (see lines 9-24 of column 5, particularly lines 15-17) discloses testing of electronic devices to a test site using synchronously operated two handlers 2-1 and 2-2 at the same time. Here, electronic devices of both groups (see 8 and 15 in fig. 8) are loaded to a test station (15) before testing. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to load first group and a second group of electronic devices as taught by Onishi in fig. 8 and then test the first group and a second group of electronic devices as thought in fig. 6, since selection of any of these known testing method would be within the level of ordinary skill in the art.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Onishi (fig. 6-7) as applied to claim 14 above, and further in view of Onishi (fig. 8 and 5).

Regarding claim 17, Onishi in fig. 5-6 discloses all the elements and is silent about the steps (b) and (c) of claim 14 are **simultaneously operable**. Rather, Onishi discloses simultaneous testing of two groups of electronic devices (see fig. 6) in different trays 14. Onishi also discloses moving of tray 14 in a circular manner from and back to loader section 16 (see lines 50-55 of column 2). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to disconnect tray 14 from tester interface (test station 15b) and connect another tray 14 to a tester interface (station 15a) simultaneously as claimed, since circular movement of tray 14 in different test station for testing with other trays 14 loading after it for testing is art-recognize equivalents and hence simultaneous steps as claimed would be within the level of ordinary skill in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paresh Patel whose telephone number is 572-272-1968. The examiner can normally be reached on 8:00 to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on 571-272-2034. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paresh Patel
February 02, 2005